

Appl. No. : 09/694,667
Filed : October 23, 2000

COMMENTS

In response to the Office Action mailed June 29, 2002, Applicant respectfully requests the Examiner to reconsider the above-captioned application in view of the foregoing amendments and the following comments.

In the Office Action, the Examiner rejected Claims 29-34, 37-50 and 59-82 as anticipated and Claims 35 and 36 as unpatentable over a document identified as "Pentax Magnet Eyeglass Frame" and has rejected Claims 83-89 as anticipated by Chao (5,569,207). The rejections are respectfully traversed for reasons more fully set out below.

In order to define better the scope of protection sought, Applicant has effected further amendments to the claims previously on file and added new Claims 90-106. The amendments to the independent claims are of a clarifying nature not necessitated by any rejections made by the Examiner. To facilitate consideration of these claims, a request for continuing examination (RCE) accompanies this response.

The rejection by the Examiner on the basis of the Pentax document is improper as there is no basis for believing that such a document is a publication within the meaning of 35 U.S.C. § 102(b). The document was listed on PTO 1449 in order to comply with the requirement for full and complete disclosure. However it will be noted that this is listed as "distributed" on or about June 28 1995 with no acknowledgment that it was "published". As summarized in Chisum at section 3:04[2], a distribution to a limited group with an injunction to secrecy is not a publication. The injunction need not be express. It is sufficient that the document is by its nature an "internal" one not intended to be distributed and not in fact distributed beyond the organisation or company. *In re Katz*, 592 F.2d 1169 (dealing with the issue of whether an internal

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corporate memorandum constituted a publication). The nature of the Pentax document makes it clear that this is an internal document setting forth answers to hypothetical questions. The title is "New Product Announcements Supporting Material". The questions anticipated in some cases raise concerns about the utility, product liability and health issues and, therefore, reinforce the intention that this document would be maintained for internal use. There is no indication in the document that such presentations were ever made, or the nature of the product described.

It is believed that this document only became available to the owner of the present application as a result of an interference proceeding involving the Chao '207 patent. Accordingly it is submitted that the Examiner is not entitled to rely on this document without establishing that it qualifies as a publication under 35 U.S.C. § 102(b). Accordingly the rejection of the claims on the basis of this document is traversed.

Notwithstanding the status of the Pentax document as a reference, the independent claims 29, and 59, against which it is cited, are believed to distinguish over the teachings of the Pentax document. Claims 29 and 59 are directed to the structural features related to the integration of the magnetic member with the closing block.

Claim 29 recites, among other limitations, the provision of an attachment housing that incorporates a magnetic member and permits first and second ends of a lens retainer to be secured to one another. This is not disclosed or suggested in the Pentax document. Accordingly Claim 29 is believed to clearly and patentably distinguish over the Pentax document.

Similarly, Claim 59, recites, among other limitations, the provision of a closing block integrated with a uniblock, which is not disclosed or suggested in the Pentax document.

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Accordingly it is submitted that even if the Pentax document is a publication citable under 35 U.S.C. § 102 (b), it does not anticipate or render obvious the subject matter of Claims 29 and 59 and the claims dependent thereon.

Editorial amendments have been made to the balance of the amended claims to correct syntax and grammatical errors. These editorial amendments do not narrow the scope of the claims but merely clarify the language used.

The Examiner has rejected Claims 83-89 on the basis of Chao. Claim 83 recites, among other limitations, a closing block integrally formed with the attachment housing, which is not taught or suggested by Chao. In rejecting Claim 83, the Examiner relied on Figure 6 of Chao to find the structure disclosed. Applicant has reviewed that disclosure but do not believe the features recited in the claim are found in Chao. Applicant has deleted from Claim 83 reference to the front side and rear side of the lens to avoid any confusion with respect to the use of the term "side". In the event that Applicant has not appreciated the Examiners comments properly, a further explanation thereof is requested.

Claim 83 is believed to distinguish over Chao and, as such, is believed to be in order for allowance. Accordingly, each of the claims depending from Claim 83 is also believed to clearly and patentably distinguish over the Chao reference.

A terminal disclaimer in compliance with 37 CFR 1.130(b) is enclosed to overcome the double patenting rejection.

Further favorable consideration is respectfully requested.

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CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney in order to resolve such issue promptly.

Respectfully submitted,

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VERSION WITH MARKINGS SHOWING CHANGES

IN THE CLAIMS:

Claims 29, 32, 35-40, 42 and 83 have been amended as follows:

29. **(Twice Amended)** Eyewear comprising a primary frame and an auxiliary frame adapted to be superimposed over a forward portion of said primary frame, said primary frame comprising a first lens and a second lens, said auxiliary frame comprising a third lens and a fourth lens, a first attachment housing extending from said first lens, a second attachment housing extending from the second lens, **[said first attachment housing and said second attachment housing each comprising at least one of an endpiece, a hinge and at least a portion of a closing block,]** a third attachment housing extending from the third lens, a fourth attachment housing extending from the fourth lens, each of said attachment housings having an abutment face, said third attachment housing extending rearward **[to abut a portion]** to position its abutment face in contact with the abutment face of said first attachment housing, said fourth attachment housing extending rearward **[to abut a portion]** to position its abutment face in contact with the abutment face of said second attachment housing, a first **[securing]** magnetic member embedded within said first attachment housing and a second **[securing]** magnetic member embedded within said second attachment housing, said first **[securing]** magnetic member and said second **[securing]** magnetic member having an exposed face parallel to respective ones of said abutment faces and engaging with at least a portion of said third attachment housing and at least a portion of said fourth attachment housing respectively when said abutment faces are positioned in contact such that said auxiliary frame [a] is secured in position relative to said primary frame, said first and second attachment housings each having a first portion secured to one end of a lens retainer and a second portion secured to an opposite end of a lens retainer and a fastener to connect said first and second portions to one another to locate said lens in said primary frame.

32. **(Amended)** The eyewear of Claim 29, wherein said first and second **[securing member is a magnet]** magnetic members are magnets.

35. **(Amended)** The eyewear of Claim 32, wherein said magnet is oriented along **[comprises]** a generally horizontal axis and said magnet is exposed on a front surface of said **[first]** attachment housing.

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36. **(Amended)** The eyewear of Claim 32, wherein said magnet is oriented along [comprises] a generally horizontal axis and said magnet is exposed on a rear surface of said [first] attachment housing.

37. **(Amended)** The eyewear of Claim 32, wherein said magnet is oriented along [comprises] a generally vertical axis and said magnet is exposed on a top surface of said [first] attachment [housing] housings.

38. **(Amended)** The eyewear of Claim 32, wherein said magnet is oriented along [comprises] a generally vertical axis and said magnet is exposed on a bottom surface of said [first] attachment [housing] housings.

39. **(Twice Amended)** The eyewear of Claim 29, wherein said [first] second portion of said attachment housing comprises said at least a portion of a closing block.

40. **(Amended)** The eyewear of Claim 39, wherein said first portion of said attachment housing comprises a recess that receives a flange of said closing block.

42. **(Amended)** The eyewear of Claim 41, wherein said [first securing member is a magnet and said magnet] magnetic member extends through both portions of said split attachment housing.

83. **(Amended)** Eyewear comprising a first lens [comprising a front side and a rear side], a temple extending rearward from a side of said first lens, an attachment housing connected to said first lens and extending to a side of said first lens different from said temple, said attachment housing comprising a mounting surface, at least one second lens [comprising a front side and a rear side and]designed to be worn in front of said first lens, an arm connected to said second lens and extending to a side of said second lens, said arm extending rearward over said attachment housing to abut at least a portion of said mounting surface of said attachment housing, a first magnet connected to one of said attachment housing and said arm and magnetic material attached to the other of said attachment housing and said arm in such a manner that the magnet and the magnetic material are attracted to each other and help to keep the second lens in place with respect to the first lens, said attachment housing having a closing block integrally formed therewith.